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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/752,879	01/06/2004	Peter R. Brownell	P06605US00	4552
22885	7590	04/08/2005	EXAMINER	
MCKEE, VOORHEES & SEASE, P.L.C. 801 GRAND AVENUE SUITE 3200 DES MOINES, IA 50309-2721			O'CONNOR, GERALD J	
			ART UNIT	PAPER NUMBER
			3627	

DATE MAILED: 04/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/752,879

**Applicant(s)**

Brownell

**Examiner**

O'Connor

**Art Unit**

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on January 6, 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 20040106
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_

## DETAILED ACTION

### *Claim Objections*

1. Claim 11 is objected to because of the following informality: it appears that "claim 8" (line 1) was intended to be --claim 10--, which change will be assumed for purposes of further consideration of the claim, hereinbelow. Appropriate correction (or clarification) is required.

### *Claim Rejections - 35 USC § 101*

2. The following is a quotation of 35 U.S.C. 101:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1-18 are drawn to a method of producing a disembodied data structure. It has been held that such claims are considered to comprise non-statutory subject matter, for merely manipulating an abstract idea without producing any "useful, concrete, and tangible result." *In re Warmerdam*, 33 F.3d 1354; 31 USPQ2d 1754 (Fed. Cir. 1994).

Additionally, method claims that fail to *require* the use of any technology, such as claims 1-18, are considered non-statutory under § 101, for failing to fall within the technological arts. Claims must be tied to a technological art. To overcome this aspect of the rejection, a positive limitation in the body of the claim is required to recite the use of some technology, such as either a computer, *per se*, or else some other computer element that would inherently and necessarily require a computer (e.g., a website), or else some other aspect or element of technology.

*Claim Rejections - 35 USC § 103*

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uemura (US 2001/0027429).

Uemura discloses a method of selling replacement parts for a product over a computer network, comprising: providing a plurality of product selections for the customer to select from; receiving a product selection of one of the products; providing a schematic illustrating a plurality of component parts of the product with associated reference identifiers; and, receiving a selection of at least one of the component parts, but Uemura does not disclose providing a plurality of product manufacturer selection options for a customer to select from and receiving a manufacturer selection of one of the product manufacturers, as the website of Uemura is for a single manufacturer. However, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the method of Uemura so as to allow the customer to select a product manufacturer from a plurality of product manufacturer options, rather than being limited to only ordering parts for products of a single manufacturer, since it is well settled that mere duplication of the essential working parts of a device involves only routine skill in the art.

*In re Harza*, 124 USPQ 378 (CCPA 1960). See MPEP § 2144.04(VI)(B).

Regarding claims 2, 9, and 14, the method of Uemura further comprises providing a description of the component part selected, including at least one name for the component part and at least one manufacturer part number for the component part.

Regarding claims 3, 8, and 19, the product of the method of Uemura is not a firearm product. However, sales of firearm products are well known, hence obvious, to those of ordinary skill in the art, and official notice to that effect is hereby taken. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have adapted the method of Uemura to instead sell firearm products, as is well known to do, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results, merely as a matter of design choice.

Regarding claims 4, 5, 16, and 17, the reference identifier in the method of Uemura is a selectable reference numeral, and the schematic in the method of Uemura is an exploded view.

Regarding claims 6 and 12, the method of Uemura further comprises receiving an order for the component part from the customer.

Regarding claims 7, 13, and 15, the description in the method of Uemura includes only one name and one part number associated with each component part. However, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the method of Uemura so as to have had more than one name/part number associated with each component part, since it is well settled that the mere duplication of the essential working parts of a device involves only routine skill in the art. *In re Harza*, 124 USPQ 378 (CCPA 1960). See MPEP § 2144.04(VI)(B).

Regarding claims 10 and 11, the components sold in the method of Uemura are not restricted, so no special authorization is required. However, restricting sales of certain gun components (e.g., silencers, full-auto kits/components, etc.) to be sold only to authorized (i.e., licensed) persons is well known, hence obvious, to those of ordinary skill in the art, and official notice to that effect is hereby taken. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have further modified the method of Uemura so as to sell restricted gun components, but to sell the restricted components only to properly authorized persons, as is well known to do, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results, merely as a matter of design choice.

Regarding claim 18, the reference identifiers in the method of Uemura are not listed in alphabetical order according to the part names. However, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the method of Uemura so as to list the reference identifiers in alphabetical order according to part names, merely as a matter of arbitrary design choice, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

*Conclusion*

6. The prior art made of record and not relied upon is considered pertinent to the disclosure.
7. Any inquiry concerning this communication, or earlier communications, should be directed to the examiner, **Jerry O'Connor**, whose telephone number is **(703) 305-1525**, and whose facsimile number is (703) 746-3976.

The examiner can normally be reached weekdays from 9:30 to 6:00.

PLEASE TAKE NOTICE that on April 14, 2005 the examiner's telephone and facsimile numbers will be changing, to (571) 272-6787 and (571) 273-6787, respectively.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Mr. Robert Olszewski, can be reached at (703) 308-5183, or, beginning April 14, 2005, at (571) 272-6788.

Official replies to this Office action may be submitted by any *one* of fax, mail, or hand delivery. **Faxed replies are preferred and should be directed to (703) 872-9306** (not changing). Mailed replies should be addressed to "Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450." Hand delivered replies should be delivered to the "Customer Service Window, Randolph Building, 401 Dulany Street, Alexandria, VA 22314."

GJOC

April 1, 2005



Gerald J. O'Connor

Patent Examiner

Group Art Unit 3627